

## REMARKS

The applicants respond herein to the Official Action mailed by the Office on 27 August 2004, and request entry and consideration of this response.

5 The applicants wish to express their appreciation for the Office re-opening prosecution of this application, as indicated in Paragraph 1 of the Action. The applicants elect to file this response under 37 CFR § 1.111 to proceed with prosecution of this application.

In preparing this response, the applicants have noted and corrected various informalities appearing in claims 198, 202, 212, and 216-219. The applicants have also corrected the status identifier for claim 249, as noted on the Advisory Action mailed on 14 January 2004.

10 As stated in paragraph 2.1 of the Action, claim 178 was rejected under § 112, 1<sup>st</sup> paragraph, and as stated in paragraph 2.2, this same claim was rejected under § 112, 2<sup>nd</sup> paragraph. Solely to expedite the prosecution of the instant application, and without any waiver, prejudice, or disclaimer of the right to claim the subject matter recited in this claim, the applicants cancel claim 178. The applicants thus submit that these two § 112 rejections are now  
15 mooted.

1. *Independent Claim 172*

As stated in Paragraph 4.1 of the Action, independent claim 172 stands rejected under § 103(a) as being unpatentable over Lynch in view of Joseph, further in view of Walker. Pending claims 173-219 depend from claim 172 and are rejected under § 103 in view of Lynch, Joseph,  
20 Walker, and various other art.

Turning to claim 172 in particular, the applicants have amended it as indicated above, and reproduce part of claim 172 here for convenience of discussion, with the above redlines included:

25 “utilizing at least in part the primary transaction data, including the purpose of the primary transaction and the second data element, and to determining determine at least one item for prospective upsell to the prospective customer in real time with the primary transaction, wherein the item ~~which~~ is different than the first good or service-, and”

The applicants submit that United States patent No. 6,055,513 (hereafter, the ‘513 patent), which is a parent of the instant application, fully supports the feature of determining an upsell item in real time with the primary transaction. More particularly, the ‘513 patent discusses gathering inputs for the upsell determination and accessing databases using such inputs in at least the following places: column 14, lines 5-10 and lines 27-29; column 17, lines 55-60; column 18, lines 15-20; and column 22, lines 25-30.

Turning to the applied art, the applicants agree with the assessment on page 6 of the Action that Lynch in view of Joseph does not teach that the alternative item is an upsell item. However, assuming for the sake of discussion that Walker discloses an upsell item, the applicants respectfully submit that Walker does not disclose an upsell item that is determined in real time with the primary transaction. Instead, Walker appears to teach upsells that are printed on account billing statements for subsequent delivery to account holders. See, e.g., Walker Abstract.

Even assuming for the sake of discussion that Walker is properly combined with Lynch and Joseph, that the applicants’ claimed “primary transaction” corresponds to Walker’s “billing items” (or the transactions from which these “billing items” resulted), and that the applicants’ claimed “item” corresponds to Walker’s “upsells”, the applicants submit that Walker does not provide what is missing from Lynch and Joseph to teach or fairly suggest at least the above-quoted portion of claim 172, and thus to support a § 103 rejection of claim 172. More particularly, the applicants submit that Walker appears to be silent as to when its upsell is actually determined relative to the primary transaction, and does not specify whether its upsell is determined when the “primary” transaction underlying the “billing item” occurs, when the billing statement is actually printed, or at some other time between these two events. Thus, the applicants submit that Walker does not support a § 103 rejection of claim 172, which recites in pertinent part “... determin[ing] at least one item for prospective upsell to the prospective customer *in real time with the primary transaction ...*”.

On at least this basis, the applicants request reconsideration and withdrawal of the § 103 rejection of independent claim 172.

## 2. *Dependent Claim 195*

As stated on page 8 of the Action, claim 195, which depends from independent claim 172 discussed above, stands rejected under § 103 as being unpatentable over the same combination of art cited against claim 172. For convenience of discussion, claim 195 is reproduced here, with emphasis added:

5           195.   (previously presented) The method of claim 172 wherein offering the item to the prospective customer includes *offering the item to the prospective customer in real time with the primary transaction.*

Since claim 195 depends from claim 172, the above comments regarding claim 172 are equally applicable to claim 195. As also noted above, the applicants agree with the assessment  
10   on page 6 of the Action that Lynch in view of Joseph does not teach that the alternative item is an upsell item. However, the applicants further submit that Walker does not supply the teaching missing from Lynch and Joseph necessary to support a § 103 rejection of claim 195. Claim 195 recites not only offering an item, which neither Lynch nor Joseph teach, but also recites offering this item to the customer in real time with the primary transaction. The applicants submit that if  
15   Lynch and Joseph do not teach upsell items, then these two references also do not teach upsell items offered in real time with the primary transaction.

Turning to Walker, it appears that Walker discloses an upsell that is offered to account holders via an account statement that is printed and delivered to the account holder well after the occurrence of the transactions whose corresponding billing items printed on the statement.  
20   Although the Walker upsell items appear to be chosen based on “upsell offer conditions”, it appears that these upsell items are chosen well after the occurrence of the transactions that result in the billing items that are reported on the billing statement. Assuming typical 30-day account billing cycles, a given Walker upsell item could be presented to an account holder via the billing statement as many as thirty days after the underlying transaction occurs. Further, Walker  
25   appears to teach that this delay may be desirable in the context of its particular teachings, for example at column 3, lines 4-19. Thus, Walker’s upsell appears to be offered to the account holder well after the claimed “primary transaction” occurs, and on at least this basis, the applicants submit that Walker fails to teach an upsell item offered in real time with a primary transaction, and thus does not provide the teaching missing from Lynch and Joseph necessary to  
30   support a § 103 rejection of claim 195.

On at least the foregoing bases, the applicants request reconsideration and withdrawal of the § 103 rejection of claim 195.

3. *Conclusion*

5 The applicants have amended the claims as shown above and have submitted these comments solely to expedite prosecution of this application. More particularly, the applicants expressly reserve the right to traverse the rejections of the claims pending herein on any other grounds in the future.

10 Favorable action is requested at the Office's earliest convenience. If discussion of this application would advance prosecution of this application, the Office is requested to contact the undersigned at the telephone number listed below.

Dated: 24 NOV 04

Respectfully submitted,

By: 

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